

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAKI OGURO, MASATO YAMAGUCHI
and YOICHIROU SENSU

Appeal No. 1997-2857
Application 08/171,175

ON BRIEF¹

Before THOMAS, RUGGIERO and BARRY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-5. Claims 6-9, directed to a non-elected

¹ Appellants' attendance at the oral hearing set for March 6, 2000, was waived in the communication received on February 11, 2000.

invention, have been withdrawn from consideration.

The claimed invention relates to a video tape recorder in which absolute track addresses are recorded in at least some of a plurality of tracks on a magnetic tape. The absolute track address, recorded in the subcode area of the tracks, corresponds to the distance of a track from the start position of the magnetic tape. A controller initiates recording from a track having a predetermined absolute track address corresponding to a predetermined distance from the start position.

Claim 1 is illustrative of the invention and reads as follows:

1. A video tape recorder for recording and reproducing audio and video signals in tracks on a magnetic tape, comprising:

means for recording and reproducing absolute track addresses in each of at least some of a plurality of tracks on a magnetic tape, the absolute track address of said each of at least some of the plurality of tracks corresponding to a distance of said each of at least some of the plurality of tracks from a start position of the magnetic tape, the absolute track addresses being incremented or decremented in a predetermined manner with increasing track position along a recording direction of the magnetic tape;

the recording and reproducing means being operative to record audio and video signals in the plurality of tracks; and

Appeal No. 1997-2857
Application 08/171,175

control means for controlling the recording and reproducing means to initiate recording of the audio and video signals from a track having a predetermined absolute track address corresponding to a predetermined distance from the start position of the magnetic tape, while preventing recording of any audio and video signals by the recording and reproducing means at any location on the tape preceding the predetermined absolute track address;

the control means being further operative to control the recording and reproducing means to record at least one absolute track address at a position on the magnetic tape preceding the predetermined absolute track address.

Appeal No. 1997-2857
Application 08/171,175

The Examiner relies on the following prior art:

Dujari et al. (Dujari)	4,811,124	Mar. 07, 1989
Fincher et al. (Fincher)	5,341,251	Aug. 23, 1994

(Filed Feb. 28, 1992)

QIC Development Standard (QIC), "Serial Recorded Magnetic Tape Cartridge for Information Interchange", Quarter-Inch Cartridge Drive Standards, Inc. Santa Barbara, California, QIC-91-43, Revision C, pp. 1-48, (February 26, 1992).

Claims 1-5 stand finally rejected as being drawn to an inadequate disclosure and as being vague and indefinite under the first and second paragraphs, respectively, of 35 U.S.C. § 112. Claim 1 stands further finally rejected under 35 U.S.C. § 102(e) as being anticipated by Fincher. Claims 2-5 stand further finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Fincher in view of QIC with respect to claim 2, and Fincher in view of Dujari with respect to claims 3-5.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and Answers for the

²The Appeal Brief was filed January 16, 1996. In response to the Examiner's Answer dated April 24, 1996, a

Appeal No. 1997-2857
Application 08/171,175

respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answers.

It is our view, after consideration of the record before us, that the disclosure in this application describes the claimed invention in a manner which complies with the requirements of the first paragraph of 35 U.S.C. § 112. We are also of the view that the claims particularly point out the invention in a manner which complies with 35 U.S.C. § 112,

Reply Brief was filed June 3, 1996, which was entered as a result of a favorable decision on petition filed under 37 CFR § 1.181. A Supplemental Examiner's Answer was submitted on January 17, 1997.

Appeal No. 1997-2857
Application 08/171,175

second paragraph. In addition, it is our opinion that the disclosure of Fincher does not fully meet the invention as recited in claim 1. Finally, we are of the conclusion that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 2-5. Accordingly, we reverse.

Appeal No. 1997-2857
Application 08/171,175

With respect to the 35 U.S.C. § 112, first paragraph, rejection, we note that the Examiner, instead of relying on the "written description" or "enablement" language of the statute, has used the terminology "lack of support" in the statement of the rejection. Our reviewing court has made it clear that written description and enablement are separate requirements under the first paragraph of 35 U.S.C. § 112. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991). The terminology "lack of support" has also been held to imply a reliance on the written description requirement of the statute. In re Higbee and Jasper, 527 F.2d 1405, 1406 188 USPQ 488, 489 (CCPA 1976).

In view of the factual situation presented to us in this instance we will interpret the Examiner's basis for the 35 U.S.C. § 112, first paragraph rejection as reliance on the "written description" portion of the statute. "The function of the description requirement [of the first paragraph of 35 U.S.C. § 112] is to ensure that the inventor has possession, as of

Appeal No. 1997-2857
Application 08/171,175

the filing date of the application relied on, of the specific subject matter later claimed by him." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." Wertheim, 541 F.2d at 262, 191 USPQ at 96 citing In re Smythe, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973). Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985), citing In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In establishing a basis for a rejection under the written description requirement of the statute, the Examiner has the initial burden of presenting evidence or reasons why persons

skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 265, 191 USPQ at 98. After reviewing the arguments of record, however, it is our opinion that the Examiner has not provided sufficient reasons or evidence to satisfy such burden.

The Examiner asserts (Answer, pages 4 and 5) a lack of description of the recording of an absolute track address signal on a tape at a position which precedes the predetermined absolute track address position. It is our view, however, that a review of Appellants' specification would reveal to the skilled artisan that such a recording of absolute track addresses is taking place. As pointed out by Appellants (Brief, page 9), the specification at page 37, lines 16-22 discloses that absolute track addresses are recorded in subcode areas of each track along the tape to define tape areas such as the recording servo actuating area R and the invalid data recording area S illustrated in Figure 25. Further, as described at pages 34 and 35 of Appellants' specification with reference to the Figure 25 embodiment, the

recording process, which includes the recording of absolute track addresses, begins at a distance L from the tape top with such recording. The recording of audio and video signals, however, is prohibited until the end of the area S or at a distance L_e from the tape top, i.e. after the predetermined absolute track address position (Specification, page 35, lines 5-22). In our view, therefore, it logically follows that absolute track addresses are recorded at a position on the tape that precedes the predetermined absolute track address. It is our conclusion that, under the factual situation presented in the present case, Appellants have satisfied the statutory written description requirement because they were clearly in possession of the invention at the time of filing of the application. Therefore, we do not sustain the rejection of claims 1-5 under the first paragraph of 35 U.S.C. § 112.

Turning to a consideration of the 35 U.S.C. § 112, second paragraph, rejection of claims 1-5, we note that the general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and

particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

This rejection is related to the 35 U.S.C. § 112, first paragraph, rejection discussed supra, and involves the clarity of the claim language "absolute track address". The Examiner states at page 6 of the Answer that:

This rejection will stand or fall with the
35 U.S.C. § 112, first paragraph rejection, ...

As we discussed earlier in this decision, we find no inadequacy in Appellants' disclosure of "absolute track addresses" and their recording in specified positions on the tape. We, likewise, find no ambiguity or lack of clarity in the use of such terminology in the claims. It is our view that the skilled artisan, having considered the specification in its entirety, would have no difficulty ascertaining the scope of the invention recited in claims 1-5. Therefore, the

Appeal No. 1997-2857
Application 08/171,175

rejection of claims 1-5 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We next consider the rejection of independent claim 1 under 35 U.S.C. § 102(e) as being anticipated by Fincher. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claim 1, the Examiner attempts to read the various claim limitations on the disclosure of Fincher (Answer, page 3, which makes reference to the final Office action mailed May 15, 1995, paper no. 11). In particular, the Examiner points to the illustrations in Figures 5 and 8 and accompanying descriptions at columns 13,

Appeal No. 1997-2857
Application 08/171,175

15, and 31 of Fincher.

After careful review of the Fincher reference in light of the arguments of record, we are in agreement with Appellants' arguments as stated in the Briefs. At the most fundamental level, as pointed out by Appellants (Brief, page 23), there is no disclosure in Fincher of recording or reproducing audio or video signals, limitations which are clearly present in claim 1. On this basis alone, the Examiner's 35 U.S.C. § 102(e) rejection of claim 1 cannot be sustained.

Several other deficiencies are also apparent from our review of Fincher. To the extent that Fincher records absolute track addresses at all, they are recorded in a single longitudinal track rather than "in each of at least some of a plurality of tracks" as claimed. Further, although the Examiner has suggested that column 15, lines 32-42 of Fincher suggests the inhibiting of recording before a certain address portion of a tape, there is no disclosure of such inhibition being related to a predetermined absolute track address as claimed.

In view of the above discussion, it is our opinion that, since all of the claim limitations are not present in the

Appeal No. 1997-2857
Application 08/171,175

disclosure of Fincher, the Examiner's 35 U.S.C. § 102(e) rejection of independent claim 1 can not be sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103 rejections of claim 2 as unpatentable over Fincher in view of QIC and claims 3-5 as unpatentable over Fincher in view of Dujari, we do not sustain these rejection as well. Each of claims 2-5 are ultimately dependent on claim 1, the limitations of which are not disclosed by Fincher as we determined in our discussion supra. Further, our review of the disclosures of QIC and Dujari reveals nothing which would overcome the innate deficiencies of Fincher. Accordingly, since the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103 rejection of appealed claims 2-5.

In conclusion, we have not sustained any of the Examiner's rejections of the claims on appeal. Accordingly, the Examiner's decision to reject claims 1-5 is reversed.

REVERSED

Appeal No. 1997-2857
Application 08/171,175

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)	BOARD OF PATENT
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Administrative Patent Judge)	AND
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Appeal No. 1997-2857
Application 08/171,175

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